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10/663,899	09/16/2003	James P. von Wolske	VONW:0001D	4515

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LAW OFFICES OF GARY R. STANFORD
330 W OVERLOOK MOUNTAIN RD
BUDA, TX 78610

EXAMINER

SAWHNEY, HARGOBIND S

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/663,899
Filing Date: 9/16/2003
Appellant(s): James P. von Wolske

MAILED
JAN 29 2007
GROUP 2800

Gary R. Stanford
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 28, 2005 appealing from the Office action mailed November 30, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Aube' et al. (U.S. Patent No. 6,672,240).

Aube' et al. ('240) discloses a docking light system (Figure 2) comprising:

- a first -left - and second – right- docking light fixtures 158 each including a docking lamp 12; and an accessory lamp 11 mounted to the respective light fixtures 158.
- the first and second accessory lamps 11 collectively a mast lamp light because of their location in the front (the bow region) of the boat.

3. Claims 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiggerman (U.S. Patent No. 5,339,225).

Regarding claims 13-15, Wiggerman ('225) discloses a docking light system (Figure 1) comprising a docking light system:

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- a docking light fixture 10 receiving a docking lamp 40; and a navigation light 35 provided on the docking light fixture 10 (Figure 1, column 3, lines 20-22, and 50-52);
- the navigation light 35 being a masthead light – positioned in the bow region of the boat- (Figure 1, column 3, lines 27-34); and
- the navigation light 35 being a stern light – positioned in the stern region of the boat- (Figure 1, column 3, lines 27-34).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiggerman (U.S. Patent No. 5,339,225).

Regarding claims 16 and 17, Wiggerman ('225) discloses a docking light system (Figure 2) comprising a docking lamp and a navigation lamp. Wiggerman ('225) further teaches additional uses of the navigation lamp including a mast light and stern light. However, Wiggerman ('225) does not specifically teach the navigation light, included in the docking light fixture, comprising a port side marker light or a starboard side marker light.

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It would be have been obvious to one of ordinary skill in the art at the time of the invention to locate the docking light fixtures either in starboard or port regions of the boat, and make use of the docking light fixture as either a starboard side marker light or a port side marker light, since it has been held that rearranging parts of an invention involves only routine skill in the art.

Regarding Claim 20, Wiggerman ('225) discloses a watercraft (not shown, column 4, lines 3-8) including a docking light system (Figure 2) comprising a docking lamp and a navigation lamp. Wiggerman ('225) further teaches additional uses of the navigation lamp, including a mast light and stern light, depending on the location selected for the lamp use (Figure 1, column 3, lines 27-34).

However, Wiggerman ('225) does not specifically teach the navigation light, included in the docking light fixture, provided on the hull of the boat

It would be have been obvious to one of ordinary skill in the art at the time of the invention to mount the docking light fixtures on the hull of the boat, since it has been held that rearranging parts of an invention involves only routine skill in the art.

(10) Response to Argument

Applicant's arguments filed on September 28, 2005 with respect to the 35 U.S.C. 102(e) rejections of claims 11-15, and 35 U.S.C. 103(a) rejection of claim 20 have been fully considered but they are not persuasive.

Argument: Regarding the amended claim 11, US Patent No. 6,672,240 B1 (Aub'e) teaches light fixtures 158, each including lights 11, which do not comprise a masthead light as recited in claim 11.

Response: Claim 11 does not recite specific structural or apparatus element limitation(s) distinguishing the recited masthead light from other navigation lights. Further, the arguments respective to the masthead lights circle around the intended uses of a masthead light. The apparatus claim must be structurally distinguishable from the prior art. Further, manner of operating the device does not differentiate apparatus claim from the prior art.

Argument: The first and second courtesy lights 11 in the fixture 158 disclosed by Aube cannot function as a masthead light.

Response: The arguments respective to the masthead lights circle around the intended uses of a masthead light. The apparatus claim must be structurally distinguishable from the prior art. Further, manner of operating the device does not differentiate apparatus claim from the prior art.

Argument: Aube's courtesy lights 11 cannot be seen on either side of the boat

Response: Claim 11 or any of its dependent claims does not recite any limitation respective to the argument. Further, the arguments respective to the masthead lights circle around the intended uses of a masthead light. The apparatus claim must be structurally

distinguishable from the prior art. Further, manner of operating the device does not differentiate apparatus claim from the prior art.

Argument: Claim 12 specifically recites the first and second docking light fixtures are mounted at the bow of the watercraft.

Response: Aub'e teaches the first and second docking lights 158, as claimed, mounted at a bow- forward portion of a boat – (Figure 2).

Argument: Regarding claim 13, Wiggerman's wand 10 is not a docking light fixture, and cannot function as a docking light.

Response: Wiggerman discloses a lamp mounted on a boat, and the lamp meets all apparatus claim limitation recited in the claim. Claim 13 does not recites specific structural or apparatus element limitation(s) distinguishing the recited lamp from other type of docking lamp. Further, the arguments respective to the masthead lights circle around the intended uses of a masthead light. The apparatus claim must be structurally distinguishable from the prior art. Further, manner of operating the device does not differentiate apparatus claim from the prior art.

Argument: Wiggerman's teaching does not suggest to a person of ordinary skill in the art to add a docking lamp on the wand 10.

Response: Wiggerman teaches that the disclosed wand structure is intended to be used not only as a stern light but also as a bow running light

or any other applications including a docking light (Figure 2, 4 and 5, column3, lines 27-34).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As indicated above, Wiggerman teaches the possible uses, intended as a boat light, including docking light, of the disclosed illuminated wand.

Thus, the modification suggested by the examiner is not based on the knowledge gleaned only from the applicant's disclosure, the examiner has not used hindsight.


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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Sandra O'Shea
Sandra O'Shea Patent Examiner
Technology Center 2800

January 19, 2007

Conferees:

SPE: Mr. Mack Ricky L. 

SPE: Mrs. Sandra O'Shea 

Examiner: Hargobind S. Sawhney

HSS

1/19/2007